

REMARKS

Claims 25, 26, 28-32, 36 and 40-46 are pending.

I. The Examiner recommended that applicants file this second request for reconsideration after a telephone discussion of the Advisory Action.

Applicants pointed out to the Examiner the following on the telephone.

If a final rejection relies on and only cites rejections A, B, and C, and the applicant's response after final rejection traverses points A, B, C by pointing out how the USPTO's reasoning is incorrect as to points A, B, C, then the Examiner cannot issue an Advisory Action which says nothing (unresponsive) about traversed points A, B, and C but instead introduces a new ground for rejection "D." This is improper because prosecution would have to be reopened for the Examiner to cite new argument D.

This is what occurred in the Advisory Action dated August 1, 2003, paper no. 27.

The advisory action states in its entirety:

"The request for reconsideration has been considered but does not place the application in condition for allowance because the final rejection is still deemed valid. In response to applicant's remarks, it should be noted that the principles of dark field illumination are not in question. The rejections are based on what is claimed, and the references are seen to include structural features which meet those set forth in the claims. ***Concerning the feature in question, the claims merely require illumination at an angle to the optical axis, and this feature is shown by Sierch.*** Accordingly, the claims as presently recited are not seen to patentably distinguish the present invention over the prior art." (*emphasis added by applicants*).

However, *the above highlighted rejection* is really a new ground for rejection a “D” in the example above because the final rejection did not say anything about “*Concerning the feature in question, the claims merely require illumination at an angle to the optical axis, and this feature is shown by Sierch.*” This “D” rejection was not in the final rejection and only rejections present in the final rejection can be maintained, not new rejections! Otherwise prosecution has to be reopened according to the patent laws.

Instead the final rejection entirely is directed to another issue, i.e., “no direct reflection of illumination light into the illumination channels” and how that works in the present invention. That was the whole rejection of the final rejection -- and not “merely” or only illumination at an angle as is incorrectly stated in the Advisory Action, i.e. “merely.” (see paragraphs 1,2 and 3 of the final rejection)

This impermissible “D” argument is also untrue factually because claim 40 does not “merely” require illumination at an angle because claim 40 has many other limitations in the claim!

Claim 40 claims:

40. (Twice Amended) An illumination arrangement for a stereo microscope, in particular, a Greenough type comprising:

a least one illumination channel arranged in a plane essentially orthogonal to a plane of the two observation channels, wherein the illumination is effected at an angle to the optical axis of the microscope *by means of at least one light conductor so that no direct reflection of illumination light falls into the observation channels and a florescence excitation is effected through the light conductor.*

So claim 40 does not “merely” claim just one limitation (note: that’s what merely means) as is

stated by the rejection, i.e., ***“the claims merely require illumination at an angle to the optical axis, and this feature is shown by Sierch.”***

Thus, the applicants are respectfully at a complete loss because the Examiner is not even making sense! What about all the other limitations discussed in the final rejection? i.e., “wherein the illumination is effected at an angle to the optical axis of the microscope ***by means of at least one light conductor so that no direct reflection of illumination light falls into the observation channels***” These limitations cannot be ignored and alleged not to exist at all by the Examiner as was done in the cited reasoning above from the Advisory Action.

Therefore, the Examiner should allow this case because all of the rejections in the final rejection were traversed by the applicants in the Request For Reconsideration and the Examiner in turn acted improperly and illogically by citing a new D argument which is also factually untrue due to the “merely” language.

It is also very strange how the entire course of prosecution can be directed to answering and traversing the Examiner’s rejections regarding ***“by means of at least one light conductor so that no direct reflection of illumination light falls into the observation channels”*** and then the Examiner can turn around and ignore these limitations after the applicants traversed the rejections in the Request For Reconsideration.

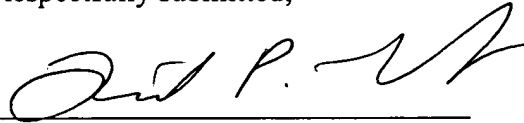
Therefore, a Notice Of Appeal had been filed, and clearly applicants will win on appeal because the Examiner is ignoring the final rejection reasoning and not making sense in the Advisory Action, which is respectfully asserted to be impermissible.

III. Conclusion.

In light of the *FESTO* case, no argument or amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No claim amendment or

argument made was for the purpose of narrowing the scope of any claim unless Applicant has explicitly stated that the argument is "narrowing." It is respectfully requested that all of the claims be reconsidered and allowed. An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel P. Lent", written over a horizontal line.

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